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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,049	08/30/2001	Thomas J. Schall	019934-002510US	8353

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EXAMINER
MOSHER, MARY

ART UNIT	PAPER NUMBER
1648	11

DATE MAILED: 11/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/944,049	SCHALL ET AL
Examiner	**Art Unit**
Mosher	1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *ONE* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-76* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims *1-76* are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-19, drawn to assay method measuring expression or activity of US28 or homolog, classified in class 435, subclass 5.

II. Claims 20-29, drawn to assay method measuring virus dissemination in an animal, classified in class 424, subclass 9.2.

III. Claims 30-63, drawn to treatment method using agent that affects US28 or homolog, classified in various class & subclass according to nature of the agent. If this group is elected, election of species is further required, see below.

IV. Claims 64-68, drawn to nucleic acid encoding chemokine-binding protein, classified in class 536, subclass 23.72. If this group is elected, election of species is further required, see below.

V. Claims 69-71, drawn to chemokine-binding protein or oligopeptide, classified in class 530, subclass 324-327 and 350. If this group is elected, election of species is further required, see below.

VI. Claims 72-76, drawn to vaccine comprising a product encoded by an inactivated US28 gene or homolog (??), classified in class 424, subclass 230.1. If this group is elected, election of species is further required, see below.

The inventions are distinct, each from the other because of the following reasons:

Groups I and II are distinct and unrelated. Although claim 20 literally depends from claim 1, the active steps required in group II do not actually involve any determination of expression or activity of US28 or homolog (as required by group I). The methods use different materials and different active steps, and are therefore seen as unrelated.

Group III is distinct and unrelated to groups I-II. Although the products used in the group III therapeutic method could be discovered by the assay methods of groups I-II, the same products could be discovered by different methods, such as classical screening methods for therapeutic agents. Group III is unrelated to groups IV-VI, because the therapeutic method as broadly claimed does not require use of the coding sequence of group IV, the protein of group V, or the vaccine of group VI (see the exception discussed below under species election).

Group IV is related to groups I and V as product and alternative processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the nucleic acids, as claimed, can be used in a the group I assay method, or in a process of making the group V polypeptide.

Group V is unrelated to the other groups; neither of the assays require these specific protein sequences; the treatment method requires an inhibitory agent, not one of these proteins;

the protein is a different product from the nucleic acid; and the vaccine requires a different product, a protein made from an inactivated coding sequence.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Group III contains claims directed to the following patentably distinct species of the claimed therapeutic method:

A. Antisense nucleic acid

B. Ribozyme

C. Antibody

D. Polypeptide encoded by inactivated gene (?)

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 30-42, 45-48, 50-57, and 62-63 are generic. If species D is elelcted, this will be examined together with group VI.

Group IV contains claims encompassing a plurality of disclosed patentably distinct species comprising nucleic acids encoding a chemokine-binding protein. No claim is generic. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Group V contains claims encompassing an astronomical number of disclosed patentably distinct species comprising any sequence which shares at least 30 residues with any 40-residuce segment of any of 8 protein sequences, or any seqeunce which comprises at least 12 amino acids from any of 8 protein sequences. No claim is generic. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Please note, for groups IV and V, election of ONE specific sequence is required.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary E. Mosher, Ph.D. whose telephone number is (703) 308-2926. The examiner can normally be reached on Monday -Thursday and alternate Fridays from 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027. The fax phone number for this Group is now (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

November 7, 2002

MARY E. MOSHER
PRIMARY EXAMINER
GROUP 1800
1600